

MARY M. BENDIK.
Serial No.: 10/027,879

8

REMARKS

Claims 1, 6, 7, 11, 12, 20 and 21 are currently amended. Claims 16 and 18 were previously canceled without prejudice. Claims 1-15, 17 and 19-26 remain before the Examiner for reconsideration.

In the Office Action dated March 25, 2004 the Examiner indicated that "the objection of the priority has been withdrawn in view of the amendment of the specification to include in the first sentence of the specification the continuation relationship of the application."

The Examiner further indicated that "the objections of drawings and the specification as failing to include item 410 and item 420 in figures 5A and 5B as disclosed in the specification have been withdrawn in view of the amendment of the specification.

Still further, the Examiner indicated that "the rejections of claims 6 and 11 under 35 U.S.C. 103(a) as being unpatentable over Porter in view of Herr-Hoyman have been withdrawn in view of Applicants' arguments."

In the Office Action, the Examiner also rejected Claims 1-5, 7-10, 12-15, 17, 19, 21, 23-26 under 35 U.S.C. 103(a) "as being unpatentable over Porter et al. (US Pat No. 5,845,067, 12/1/98, filed 9/9/96) in view of Herr-Hoyman et al. (US Pat No. 5,727,156, 3/10/98, filed 4/10/96)." Specifically, the Examiner assured that:

Regarding independent claim 1, Porter discloses:

- creating a document profile that includes fields of attributes of a document (col 3, lines 45-55, col 7, lines 26-67, figure 7)
- each document has a unique identifier for identifying the location of the document content in the file system (col 11, lines 44-55) where the unique identifier being visible to users of the document management system and providing information about the document to the users (col 11, lines 44-62: the fact that the list of the document keys is accessed by users where a *document key* consists of a *document identifier* and a service identifier suggests that the unique identifier be visible to users since the unique identifier would be also accessed when users accessing

MARY M. BENDIK
Serial No.: 10/027,879

9

the document keys; also, since the unique identifier provides the location of the document in the file system, the unique identifier provides information about the document to users)

Porter does not disclose:

- the unique identifier of a document including at least a first portion including information descriptive of an attribute of the document and at least a second portion including an automatically generated number

Heir-Hoyman discloses a scheme for generating a unique identifier wherein the unique identifier including a short sequence of characters related to a company name, possible including additional characters or digits to ensure that the generated unique ID is unique (col 3, lines 57-67)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Herr-Hoyman into Porter since Herr-Hoyman discloses a scheme for generating a unique identifier that includes a sequence of characters such as a company name with additional digits, providing the advantage to apply the unique document identifier scheme to generating a document identifier in Porter. By including an author name instead of a company name with a number or a digit *to make the identifier to be unique* (since the author name is one of the properties of document profile in Porter), this method would provide a fast way for identifying a document when accessing a document in a database.

Regarding claim 2, which is dependent on claim 1, Porter does not disclose that the first portion of the document identifier is descriptive of the author of the document.

As mentioned in claim 1, Herr-Hoyman discloses that the unique ID includes a short sequence of characters related to a company name (col 3, lines 58-62).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Herr-Hoyman into Porter since Herr-Hoyman teaches the sequence of characters is a company name and Porter provides author's name as one of the properties of a document. This motivates to use the author's name instead of the company name as a portion of the document identifier for providing the information of a document.

Regarding claims 3 and 4, which is dependent on claims 1 and 2 respectively, as disclosed in claim 1, Herr-Hoyman provides the sequential numbers in addition to the sequence of characters to ensure that the generated unique ID is unique (col 3, lines 57-65).

MARY M. BENDIK
Serial No.: 10/027,879

10

Regarding claim 5, Porter discloses that when a new document is entered into the document management system, the document content and the document profile are indexed (col 11, lines 16-22) for the purpose of criteria searching. The document identifier, therefore, is generated from the beginning before the document is entered (col 11, lines 16-51).

Also, Herr-Hoyman discloses that the first step when creating the web pages, the author of the web pages enter company data, which is an attribute of a web page and is an element to generate the unique ID (col 3, lines 50-65).

Regarding claim 7, which is dependent on claim 1, Porter discloses the linking of the document profile to a file type that is not created within the document management system (col 3, lines 45-65: the document profile is transmitted via the messaging system where the recipient of the copy of the document profile may be another file system or another server where another file system or another server is not within the document management system).

Regarding claim 8, which is dependent on claim 1, Porter does not explicitly disclose creating of an email message via a messaging system external to the document management system including a link to document profile using a selector within the document management system so that the recipient of the message can access the document associated with the document profile if the recipient has appropriate authorization to access the document associated with the document profile.

However, Porter does disclose:

- the document profile is transmitted via the messaging system where the recipient *of the copy of the document profile* may be another file system or another server where it is clear that another file system or another server is not within the document management system (col 3, lines 45-55)
- the access permission for the document profile where different levels of access permission ranging from authorization to see, to access and edit the document content, or change the access permission depending on whether the individual is a member in the group or not (col 8, lines 10-34)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Porter to include the step of creating an email message via a messaging system external to the document management system since the recipient of the transmitted document profile can be from another system or another server, *which means* an external system, and the fact that the document profile is *transmitted* by a messaging system including an email further suggests

MARY M. BENDIK
Serial No.: 10/027,879

11

that the messaging system of the recipient *linking to* document profile in the document *management system* is external to the document management system. Further, the access permission to the document associated with the document file suggests that a recipient of a transmitted document can access the document profile if the recipient has an access authorization. Also, it was well known that in sending a message, a SEND button, among other buttons on the window, is selected to press for sending a message. Said button, thus, is considered as a selector in the document management system.

Regarding claim 9, which is dependent on claim 1, Porter discloses that the email message via a messaging system external to the document management system including a copy of the document using a selector within the document management system so that the recipient of the message can access the copy of the document (col 3, lines 35-55: the recipient of the document copy is from another file system or another server, which is external to the document management system; figure 8A, col 16, lines 59-65: accessing the document content based on the information of the profile; the selector feature is mentioned in claim 8).

Regarding claim 10, which is dependent on claim 1, Porter discloses the defining of user access permission in the document profile, wherein the step of defining user access permission includes the step of acquiring the identity of the user from a source external to the document management system (col 8, lines 10-34, col 13, lines 45-61).

Independent claim 12 includes the limitations of claims 1 and 7, and therefore is rejected under the same rationale.

Regarding claim 13, which is dependent on claim 12, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have recognized that the file type is a word processing document as in Porter (figure 7, col 7, lines 29-31).

Regarding claim 14, which is dependent on claim 12, Porter discloses the file type is an email record (col 3, lines 35-50).

Independent claim 15 includes the limitations of claims 1, 7 and 8, and therefore is rejected under the same rationale.

Independent claim 17 includes the limitations of claims 1 and 9, and therefore is rejected under the same rationale.

MARY M. BENDIK.
Serial No.: 10/027,879

12

Regarding claim 19, which is dependent on claim 10, Porter discloses that the source of identity of the user is an operating system security system or a database security system (col 14, lines 10-18).

Claims 21, 23-26 are for the document management system of method claims 1, 7-10, and therefore are rejected under the same rationale.

In response to Applicant's arguments set forth in the Amendment filed January 6, 2004, the Examiner asserted that:

Regarding independent claims 1 and 21, Applicants argue that the unique ID (CID field) of Herr-Hoyman is actually a login number for which an associated password is created in connection with a web page uploaded by a client to a server on the Internet. Unlike the case of Herr-Hoyman, the unique identifier of the invention is not a security measure designed to restrict access, but designed to facilitate access without the requirement of searching (Remarks, pages 14-15).

Examiner agrees.

However, it is clear that in Herr-Hoyman, the unique identifier is for identifying a web page, which is a document, for accessing a document. In the identifier generating scheme, each unique identifier is generated by including a sequence of characters such as a company name and additional digits to make the identifier unique (col 3, lines 5767). Therefore, the created unique identifier can be applied in either restrict access or fast access since the identifier is used for quickly identifying something. Porter does teach the unique identifier for each document to identify the location of a document in a file system (col 11, lines 44-52).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Herr-Hoyman into Porter since Herr-Hoyman discloses a scheme for generating a unique identifier that includes a sequence of characters such as a company name with additional digits, providing the advantage to apply the unique document identifier scheme to generating a document identifier in Porter. By including an author name instead of a company name with a number or a digit to make the identifier to be unique (since the author name is one of the properties of document profile in Porter), this method would provide a fast way for identifying a document when accessing a document in a database.

Regarding claims 7 and 12, Applicants argue that Peter does not disclose or suggest further linking the document profile to a file type that is not created within the document management system since the 'related to'

MARY M. BENDIK.
Serial No.: 10/027,879

13

category in Porter simply lists any document within the filing cabinets of the document management system whereas the link feature of the invention links documents from other database system (Remarks, page 16).

Examiner agrees.

However, in another part of reference, Porter does disclose linking the document profile to a file type that is not created within the document management system (col 3, lines 45-65: the document profile is transmitted via the messaging system where the recipient of the copy of the document profile may be another file system or another server where another file system or another server is not within the document management system).

Regarding claims 8 and 15, Applicants argue that Porter does not disclose or suggest creating an email message via a messaging system external to the document management system including a link to the document profile using a selector within the document management system so that a recipient of the message can access the document associated with the document profile if the recipient has appropriate authorization to access the document associated with the document profile (Remarks, page 16).

Examiner respectfully disagrees.

As mentioned above, Porter discloses the document profile is transmitted via the messaging system where the recipient of the copy of the document profile may be another file system or another server where another file system or another server is not within the document management system (col 3, lines 45-55). Porter further discloses the access permission for the document profile where different levels of access permission ranging from authorization to see, to access and edit the document content, or change the access permission depending on whether the individual is a member in the group or not (col 8, lines 10-34).

It is suggested to include the step of creating an email message via a messaging system external to the document management system since the recipient of the transmitted document profile can be from another system or another server, which means an external system, and the fact that the document profile is transmitted by a messaging system including an email further suggests that the messaging system of the recipient linking to document profile in the document management system is external to the document management system. Further, the access permission to the document associated with the document file suggests that a recipient of a transmitted document can access the document

MARY M. BENDIK.
Serial No.: 10/027,879

14

profile if the recipient has an access authorization. Also, it was well known that in sending a message, a SEND button, among other buttons on the window, is selected to press for sending a message. Said button, thus, is considered as a selector in the document management system.

Applicants respectfully traverse the Examiner's rejections.

With respect to Claims 1 and 21, as admitted by the Examiner, Porter does not disclose the generation of a unique identifier for documents in a document management system. Respectfully, however, the Examiner is incorrect in the assertion that it would be obvious to combine the disclosure of Herr-Hoyman with that of Porter to incorporate the unique identifiers of the present invention into a document management system. The unique ID (C_ID field) of Herr-Hoyman is not the same as the unique identifier field generated in the present invention. The unique identifier in Herr-Hoyman is actually a login number for which an associated password is created in connection with a web page uploaded by a client to a server on the Internet. The unique identifier of Herr-Hoyman and the associated password are transmitted to the client that creates a particular web site and are maintained in confidence to prevent unauthorized individual from modifying the web page. See, for example, claim1 and Col. 1, lines43-49. The unique identifier and the password must be used to effect future modification of an uploaded web page.

Once again, there is absolutely no motivation for one skilled in the art to incorporate the generation of an identifier (login)/password system as disclosed in Herr-Hoyman into a document management system as disclosed in Porter. See, for example, Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (P.O. Bd. Appl. 1984) ("The prior art must provide a motivation or reason for a worker in the art without the benefit of appellant's specification to make the necessary changes in the reference device."); Schenk v. Norton, 218 USPQ 698, 702 (Fed. Cir. 1983) ("Modification unwarranted by the disclosure of a reference is improper."); Ex Parte Acosta, 211 USPQ 636, 637 (P.O. Bd. Appls. 1980) (Examiner's combination of two references is improper where there is no basis in the record from which it can reasonably be inferred that one skilled in the art would have been led or motivated to modify the primary reference in the manner

MARY M. BENDIK.
Serial No.: 10/027,879

15

proposed by the Examiner.) Moreover, even if one were to combine the disclosure of Herr-Hoyman with that of Porter, one would not arrive at the present invention.

To the contrary, the unique identifier field of the present invention is generated after the user authenticates, which is defined after the user creates their first document profile. Unlike the case of Herr-Hoyman, the unique identifier of the present invention is not a security measure designed to restrict access, but an identifier designed to facilitate access without the requirement of searching. In that regard, the unique identifiers of the present invention enable identification of a corresponding or associated document among a group or list including other unique identifiers corresponding to or associated with other documents. Thus, even absent the document management software of the present invention (for example, in a catastrophic failure thereof) stored documents can be identified by the associated unique identifier among a group/list of other unique identifiers associated with other stored documents. In previously available document management systems, failure of the document management software could render documents managed thereby virtually inaccessible without intensive labor/searching. Porter does not even address this problem with previously available document management systems. Applicants have amended the claims to more clearly set forth the present invention.

With respect to claim 7 and independent claim 12, Porter does not disclose or suggest further linking or creating a link in the document profile to a file type that is not created within the document management system. Although indicating the merits of Applicants' previous arguments, the Examiner asserts that:

However, in another part of reference, Porter does disclose linking the document profile to a file type that is not created within the document management system (col 3, lines 45-65: the document profile is transmitted via the messaging system where the recipient of the copy of the document profile may be another file system or another server where another file system or another server is not within the document management system).

MARY M. BENDIK
Serial No.: 10/027,879

16

The process of Porter identified by the Examiner (see Col. 3, lines 57-65) is merely a replication, copying or backup process that copies the entire document profile to another file system, another server or another client system. No link is created in the document profile of Porter to a file not created within the document management system.

To the contrary, the "link" feature of the present invention links documents from, for example, other database systems (i.e. e-mail, discussion databases, calendar files, to-do lists, financial data warehouse system, an external file that can from a floppy, cd-rom, or external file system, etc.), external to the document management system to the document profile of a document created within the database management system. In the present invention, unlike in Porter, all documents related to a document content associated with a document profile can be linked in that document profile to provide ready access thereto. A link can, for example, be a document, a report view or a database link. The links of the present invention are not limited to other document profile file types. Moreover, they are links coming from external systems.

With respect to claim 8 and independent claim 15, Porter does not disclose or suggest the step of creating an email message via a messaging system external to the document management system including a link to the document profile using a selector within the document management system so that a recipient of the message can access the document associated with the document profile if the recipient has appropriate authorization to access the document associated with the document profile. Nonetheless, the Examiner asserts that:

the document profile is transmitted via the messaging system where the recipient of the copy of the document profile may be another file system or another server where it is clear that another file system or another server is not within the document management system (col 3, lines 45-55)

Presumably, the Examiner is referring to lines 57-65 of Col. 3 of Porter in discussing "recipients" of copies of document profiles. Once again, the process of Porter identified by the Examiner is merely a replication, copying or backup process that copies the entire document profile to another file system, another server or another client system. Such a

MARY M. BENDIK
Serial No.: 10/027,879

17

replication process does not disclose or suggest that a user of the system can create an email message using a messaging system external to the document management system including a link to the document profile using a selector within the document management system.

Likewise, with respect to claim 9 and with respect to independent claim 17, Porter does not disclose the step of creating an email message via a messaging system external to the document management system including a copy of the document using a selector within the document management system so that a recipient of the message can access the copy of the document. Porter, at col. 3, lines 35-55, indicates only that the messaging system thereof, around which the document management system of Porter is constructed, includes document profiles setting forth attributes of the documents. Col. 3, lines 57-65 of Porter merely set forth a document profile replicating procedure as discussed above.

Unlike the document management methods and systems of the present invention, the document management system of Porter incorporates the messaging (email) system as a part of the document management system and stores the document profiles inside the messaging system as indicated on Figure 2, 260 and at Col. 3, lines 35-55). The document profiles and document contents of the present invention are not stored within a messaging system but in a database system of the document management system, which is separate from, but in communication with, the messaging system. The external messaging system can, however, be utilized to route a document profile for workflow purposes using selectors (e.g., graphical buttons) within the document management system, so that when the recipient receives an e-mail message the link on the e-mail message will take the user directly to the document management database system of the present invention, which will then take the user to the document profile (if the user has proper security rights to that document profile). Likewise, the external messaging system can be utilized to route a document using selectors (e.g., graphical buttons) within the document management system, so that when the recipient receives a copy of the document.

MARY M. BENDIK.
Serial No.: 10/027,879

18

The Examiner also rejected Claim 20 under 35 U.S.C. 103(a) "as being unpatentable over Porter et al. (US Pat No. 5,845,067, 12/1/98, filed 9/9/96)". Specifically, the Examiner assured that:

Regarding independent claim 20, Porter discloses:

- creating at least one document profile that includes fields of attributes of an associated document content (col 3, lines 45-55, col 7, lines 25-67, figure 7)
- storing the document profile in a database (col 7, line 26 to col 8, line 34)
- creating document content associated with the document profile (col 7, lines 25-67)
- storing the document content external to the database in a file system of a first storage device (it was well known that a created document can be stored in a different disk storage of a file system separate from the database)
- defining in the document management system at least a second storage device to which the document content is to be copied when stored in the first storage device (it was well known that one can create a new directory or a new folder for storing documents or for copying documents from another directory or another folder to)
- copying the document content from the first storage device to a second storage device (it was well known to copy files or documents from one folder or directory, which is a first storage device, to another folder or directory, which is a second storage device).

Porter does not explicitly disclose exiting document. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Porter to include exiting document since it was well known to exit a document by closing it.

In response to Applicant's arguments set forth in the Amendment filed January 6, 2004, the Examiner asserted that:

Regarding claim 20, Applicants argue that Porter does not disclose or suggest a document management system in which one can define at least a second storage area or device to which the document content is to be copied when stored in the first storage device (Remarks, page 17).

Examiner respectfully disagrees.

Porter does teach the file room, which is a form of storage for storing documents (figure 11 A, col 12, lines 4-31). Also, it was well known in

MARY M. BENDIK.
Serial No.: 10/027,879

19

document processing that one can create a new directory to copy the documents which are stored a storage in the system to.

Applicant respectfully traverse the Examiner's rejections.

With respect to Claim 20, the method of storing a document and disaster recovery of a document in the present invention is not done by previously practiced methods of replication. Porter disclosed replication of document profiles at Col. 3, lines 57-65 of Porter. Moreover, Applicants are not merely creating a new directory to which to copy files. The document management system of the present invention uses a unique programming script or code that automatically copies a document upon exiting and saving the document to the primary location. An operator of the document management system, such as an administrator, can define one or multiple disaster stores or storage devices for a particular library within the document management system. If a document is stored in a library that is defined for multiple disaster stores, then upon exiting and saving the document profile, the document profile is flagged and the agent programming script copies the document to the designated storage area(s)/devices. Porter does not disclose or suggest a document management system in which one can define at least a second storage area or device to which the document content is to be copied when stored in the first storage device and subsequent automatic (that is, accomplished by the document management systems without further action of the user once a second storage area is previous identified) copying of a saved document to that second storage area or device.

Claims 6, 11, 22 are rejected by the Examiner under 35 U.S.C. 103(a) "as being unpatentable over Porter in view of Herr-Hoyman as applied to claims 1 and 21 above, and further in view of Gibbon (US Pat No. 6,473,778 131, 10/29/02, filed 2/1/99)." Specifically, the Examiner assured that:

Regarding claim 6, which is dependent on claim 1, Porter and Herr-Hoyman do not disclose explicitly requiring selection of a predefined document template from a set of predetermined templates for the document during creation of the document profile, the document template defining the format of the document.

MARY M. BENDIK.
Serial No.: 10/027,879

20

Gibbon discloses selecting a predefined template for creating a document where the document template defines the format of the document (figure 9 and col 13, line 53 to col 14, line 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Gibbon into Porter since Gibbon teaches selecting a predetermined document template for the document wherein the document template defines the format of the document providing the advantage to apply to the creation of document in Porter by creating predetermined templates having the various properties of the document profile and of the document content for user to select. This would provide a faster and more convenient way in creating documents instead of selecting every single desired element in the document profile and in the document content to create a document.

Independent claim 11 includes the limitations of claims 1 and 6, and therefore is rejected under the same rationale.

Claim 22 is for the document management system of method claim 6, and is rejected under the same rationale.

In response to Applicant's arguments set forth in the Amendment filed January 6, 2004, the Examiner asserted that:

Regarding claims 6 and 11, Applicants argue that Porter does not disclose or suggest requiring selection of a predetermined document template for the document during creation of the document profile, wherein the document template defines the format of the document since the file room, file tray, and briefing book of Porter are not the same as the document template but merely determine how documents are organized and stored (Remarks, page 15).

Examiner agrees.

Gibbon, in combination with Porter, discloses selecting a predefined template for creating a document where the document template defines the format of the document (figure 9 and col 13, line 53 to col 14, line 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Gibbon into Porter since Gibbon teaches selecting a predetermined document template for the document wherein the document template defines the format of the document providing the advantage to apply to the creation of document in Porter by creating predetermined templates having the various properties of the document profile and of the document content for user

MARY M. BENDIK
Serial No.: 10/027,879

21

to select. This would provide a faster and more convenient way in creating documents instead of selecting every single desired element in the document profile and in the document content to create a document.

Applicant respectfully traverse the Examiner's rejections.

With respect to independent claim 6 and independent claim 11, the Examiner recognizes that neither Porter nor Herr-Hoyman discloses or suggests requiring selection of a predefined document template for the document during creation of the document profile, wherein the document template defines the format of the document as claimed in the present invention. Nonetheless, the Examiner asserts that it would be obvious to combine the disclosure of Gibbon with that of Porter and Herr-Hoyman to arrive at the present invention. However, there is absolutely no motivation in Porter, Herr-Hoyman or Gibbon for such a combination. Applicants are not merely claiming the use of document templates, which is known in the art, but the requirement of selection of a predefined document template for the document during creation of the document profile in a document management systems. Gibbon merely disclosed the use of a set of HTML templates or formats for use in creating HTML representations of transcripts of television programming and is irrelevant to the present invention.

As there is no motivation in Porter and/or Herr-Hoyman to modify the teaching therein to arrive at the present invention, Applicants respectfully assert that, the Examiner is impermissibly using the disclosure of the present invention as a guide in modifying the teachings of Porter and/or Herr-Hoyman with the teachings of Gibbon. As the Federal Circuit stated in Orthopedic Equipment Co., Inc. v. United States, 702 F. 2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983):

It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law.

Moreover, Applicants respectfully assert in any event that Gibbon cannot be combined with either Porter and/or Herr-Hoyman to arrive at the present invention. The present invention provides a predefined taxonomy, which can be specifically designed for an

MARY M. BENDIK
Serial No.: 10/027,879

22

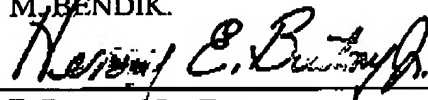
individual organization. Unlike the document management system of Porter and the templates disclosed in Gibbon, the templates of the present invention construct the taxonomy and are a mandatory field to be completed by a user in creating any type of document in the system of the present invention. The selected document template, results in launching of the appropriate software and predetermines the format used in the initial creation of the document. Applicants have amended claims 6 and 11 to more clearly set forth the present invention.

In view of the above amendments and remarks, the Applicants respectfully requests that the Examiner withdraw the rejections of the claims, indicate the allowability of claims, and arrange for an official Notice of Allowance to be issued in due course.

Respectfully submitted,

MARY M. BENDIK.

By


Henry E. Bartony, Jr., Esq.
Reg. No. 34,772

Bartony & Hare, LLP
Law & Finance Building
Suite 1801
429 Fourth Avenue
Pittsburgh, Pennsylvania 15219
412-338-8632 (telephone)
412-338-6611 (fax)

Attorney for Applicant